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Docket No.: 1353.1003C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

Mark MEISTER et al.

Serial No. 10/715,408

Group Art Unit: 2153

Confirmation No. 5313

Filed: November 19, 2003

Examiner: Krisna Lim

For: AN EMAIL SYSTEM WITH USER SEND AUTHORIZATION

REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is a reply to the Examiner's Answer mailed December 5, 2005.

In responding to the Applicant's argument that the specification supports the term "not created by the user", which term has been rejected as new matter and ignored in accessing the novelty and non-obviousness of the claims, the Examiner acknowledges, on page 6 of the Answer, that the application discusses in the background section that the term "virus" is used and on page 7 of the Answer that the term "unauthorized agent" is used in the incorporated by reference parent U.S. Patent 6,671,718.

In face of this acknowledgement, the Examiner appears to be basing the rejection on the position that by mentioning something only once in an application that this somehow is not enough to satisfy the legal requirements regarding written description support.

"... the appellants are reminded that the term **"virus"** was mentioned only once in the **background** ..."

(See Examiner's Answer, page 6, **bold** emphasis by Examiner)

"In the parent case, only once that the term "unauthorized agent" was mentioned (e.g., see col. 7, last line)..."

(See Examiner's Answer, page 7)

The Board is requested to note that it is well accepted that a satisfactory written description may be in the claims or any other portion of the originally filed application. See MPEP § 2163. Additionally, an applicant shows possession of the claimed invention by describing the limitations using words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. See Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997). A claim limitation may be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § 2163(II)(A)(3)(b).

In determining whether an application meets the "written description" requirement with respect to later filed claims, the application need not describe the claimed subject matter in exactly the same terms. See Eiselstein v. Frank, 52 F.3d 1035, 1038 (Fed. Cir. 1995). Verbatim language is not required and different language that conveys the same meaning may be sufficient. See Fujikawa v. Wattanasin, 93 F.3d 1159, 1570 (Fed. Cir. 1996). Amended claim limitations may even be inherently contained in the original application. See Schering Corp v. Amgen Inc., 222 F.3d 1347, 1352 (Fed. Cir. 2000).

"When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. § 112, first paragraph, a study of the entire application is often necessary to determine whether or not 'new matter' is involved" (emphasis added). See MPEP § 2163.06(I). Additionally, during claim construction, the entire specification is used to determine the scope of the claim. The "Background of the Invention" may be used during this determination. See Interactive Gift Express, Inc. v. Compuserve, Inc., 256 F.3d 1323, 1334-35 (Fed. Cir. 2001). Since the "Background of the Invention" section of the patent application is part of the entire application, it must therefore be considered when addressing "new matter."

In Brooktree v. Advanced Micro Devices, the Court of Appeals for the Federal Circuit ruled that there was sufficient written description for an amended limitation to satisfy 35 U.S.C. § 112, first paragraph, although there was no explicit language of the limitation. See 977 F.2d 1555, 1575 (Fed. Cir. 1992). Even though no express description was found, the court permitted inquiry into the "Background of the Invention" section of the specification. Id. at 1574. The court stated that new matter "depends on the facts of the case: the nature of the disclosure, the state of the art, and the nature of the added matter." Id. at 1575.

It is submitted that the term "not created by a user" of concern is supported and that the rejection of the term as new matter (and any implied rejection for lack of a written description) be reversed.

The Board is also requested to note that the use of the term "virus" was in the context of a problem that the invention is trying to solve:

Today computer viruses can compose and send e-mail without a user being aware of the transmission of such unauthorized e-mail.

What is needed is a system that will alert a user when an unauthorized e-mail is being sent by the user's system and allow the user to cancel the message before it is sent.

(See Application, paras. 10 and 11)

It is submitted that a virus composing and sending a message without the user being aware of such and an unauthorized e-mail being sent by the user's system is a message "not created by a user". This is clear support for the term of concern. Reversal of the rejection for new matter (and for any implied lack of a written description) for this additional reason is requested.

The Board is further requested to note that it is a fundamental principle of patent law that the recognition of a problem (as well as the solution to the problem) is part of the invention. "Furthermore, it is well settled that where the claimed invention solves a problem, the discovery of the source of the problem and its solution are considered to be part of the 'invention as a whole' ..." (see Ex parte Hiyamizu, 10 USPQ 2d 1393, 1394-95 (B.P.A.I. 1988), see also In re Nomiya, 184 USPQ 607, 612 (C.C.P.A. 1975), In re Sponnoble, 160 USPQ 237, 243 (C.C.P.A. 1969), and In re Bisley, 94 USPQ 80, 86-87 (C.C.P.A. 1952))

It is submitted that it is the applicants right to claim that which is part of the invention; i.e. recognition that a message is to be sent that was not created by a user. For this further reason, it is submitted that the rejection for new matter (and any implied rejection for lack of a written description) should be reversed.

The rejection over the art of the claims as either anticipated by Chrabaszcz or as obvious over Chrabaszcz and Rollins is founded on not considering the term "not created by a user". As such these art rejections fail when this term is considered as discussed in the Brief.

Reversal of the rejections is respectfully requested.

Respectfully submitted,

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Date:

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